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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,389	06/20/2003	Vepkhia Pilauri	03-337	4952
20306	7590	09/22/2005	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			LAMBERTSON, DAVID A	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,389

Applicant(s)

PILAUDI ET AL.

Examiner

David A. Lambertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-74 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to a method for identifying protein-protein interactions using a fusion protein comprising a first protein of interest and a transcriptional repressor, and a fusion of a second protein of interest and a cytoplasmic localization signal, and measuring the transcription of a reporter gene under the transcriptional control of a promoter responsive to said repressor, classified in class 435, subclass 7.1.
- II. Claims 22-41, drawn to a method for identifying a nuclear export sequence (NES) comprising a fusion protein of a protein with a putative NES fused to a transcriptional repressor, and measuring the transcription of a reporter gene under the transcriptional control of a promoter responsive to said repressor, classified in class 435, subclass 6.
- III. Claims 42-49, drawn to a method for identifying a nuclear localization sequence (NLS) comprising a fusion protein of a protein with a putative NLS fused to a transcriptional repressor, and measuring the transcription of a reporter gene under the transcriptional control of a promoter responsive to said repressor, classified in class 435, subclass 6.
- IV. Claims 50-74, drawn to a method for regulating gene expression by affecting the localization of the Gal80 transcriptional repressor, classified in class 435, subclass 41.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups I-III are all unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different effects. Specifically, the method of Group I is directed to the identification of protein-protein interactions (its effect), and involves the use of two separate fusion proteins comprising domains that are to be tested for interaction (its mode of operation). In contrast, the methods of Groups II and III do not utilize two separate proteins fusions (thus, having different modes of operation from Group I), and furthermore are directed to an outcome that is different than the identification of a protein-protein interaction (thus having different effects from Group I). Additionally, Groups II and III are directed to distinct outcomes themselves. Group II identifies NES signals (its effect) by identifying sequences that increase reporter gene expression (its mode of operation); Group III encompasses the complete opposite, instead identifying NLS signals by measuring a decrease in reporter gene expression. Since each of these methods makes use of different gene products (which are not commensurate in scope), is designed to deliver distinct outcomes, and makes use of different method steps to determine this outcome, the inventions are considered patentably distinct. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, restriction for examination purposes as indicated is proper.

Furthermore, especially in instances where the classifications are the same, the non-patent

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literature searches required for each of these inventions are not co-extensive, hence said searches would be burdensome. Therefore restriction for examination purposes as indicated is proper.

Inventions Groups I-III and Group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects. Specifically, the methods of Groups I-III are each designed to identify a characteristic of a given protein (i.e., it's ability to interact with another protein, to act as an NES or to act as an NLS). In contrast, the method of Group IV is not designed to identify a characteristic of a particular protein, but rather to affect the expression of proteins from a particular promoter element. Since each group clearly has a distinct effect, the inventions are considered patentably distinct. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, especially in instances where the classifications are the same, the non-patent literature searches required for each of these inventions are not co-extensive, hence said searches would be burdensome. Therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571) 272-0771. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Lambertson, Ph.D.
AU 1636



JAMES KETTER
PRIMARY EXAMINER